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MICHAEL I. STEWART
Sim & McBurney
6th Floor, 330 University Avenue
Toronto, Ontario
Canada, M5G 1R7

In re Application of
Sia et al
Application No.: 09/647,981
PCT No.: PCT/CA99/00287
Int. Filing Date: 07 April 1999
Priority Date: 07 April 1998
Attorney's Docket No.: 1038-1086 MIS:jb
For: HIV-SPECIFIC CYTOTOXIC-CELL
RESPONSES

DECISION

ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to applicants' "PETITION UNDER 37 CFR 1.47(a)" filed on 07 May 2001 that seeks the acceptance of the application without the signature of the inventor "Charles D.Y. Sia.

BACKGROUND

On 07 April 1999, applicant filed international application PCT/CA99/00287, which claimed an earliest priority date of 07 April 1998. A copy of the international application was transmitted to the United States from the International Bureau on 14 October 1999.

On 06 October 2000, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). No oath or declaration was submitted at such time.

On 08 November 2000, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the oath or declaration does not comply with 37 CFR 1.497(a) and (b). The notification set a one month time limit or 31 months from the priority date for the application, whichever is later to respond.

On 07 May 2001, applicant filed the present petition under 37 CFR 1.47(a). Filed with the present petition were, *inter alia*: (1) a "DECLARATION AND POWER OF ATTORNEY" executed by all the inventors except for Charles D.Y. Sia; (2) a "DECLARATION AND POWER OF ATTORNEY" executed by the inventor Michael Klein on behalf of non-signing inventor Charles D.Y. Sia; and (3) a "DECLARATION UNDER 37 C.F.R. 1.47(a)" executed by Mr. Michael I. Stewart.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Petitioner has not satisfied items (2) and (4), thus not completing the requirements under 37 CFR 1.47(a).

Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

"... Where a refusal of the inventor to sign the application paper is alleged, the circumstances of the refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings and oath or declaration) to the nonsigning inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration."

Notwithstanding the statements to the contrary, it does not appear that Michael I. Stewart made a *bona fide* attempt to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing joint inventor Mr. Charles D.Y. Sia, and that after presentation of the complete copy Mr. Sia refused to sign the Declaration. Mr. Stewart declares that the Declaration and Power of Attorney was forwarded to Mr. Sia to his last known address and that a follow up telephone call on 25 January 2001 concerning the status of the documentation was answered by an answering machine and a message was left. Mr. Stewart further states that to this date, Mr. Sia has not executed the Declaration and Power of Attorney. ¶¶ 5, 6 and 7 of Mr. Stewart's Declaration. However, this document, by itself, does not satisfy the requirement of section 409.03(d) because a complete copy of the application (i.e., specification, including claims and drawings) does not appear to have been presented to Mr. Sia for review and signature.

Accordingly, the current record does not support the premise that Mr. Sia's conduct constitutes refusal because a *bona fide* attempt was not made to present a copy of the application papers (specification, including claims, drawings and declaration) to Mr. Sia for his signature.

In addition, the Declaration submitted on 07 May 2001 is no good because it has been signed by only one inventor, Michael H. Klein, on behalf of the non-signing inventor Charles D.Y. Sia. Michael Stewart has not submitted an affidavit or declaration by Mr. Reza Yacoob, who has first hand knowledge of the facts recited in § 8 as required pursuant 37 CFR 1.47(a) that Peter Chong refuses to sign the declaration on behalf of Charles D.Y. Sia.

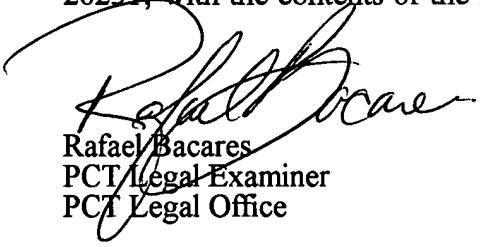
At this time it can not be concluded that Mr. Sia had refused to sign the documents based on the evidence provided. Also, it can not be concluded at this time that Peter Chong refuses to sign on behalf of Charles D.Y. Sia for the reason stated above.

DECISION

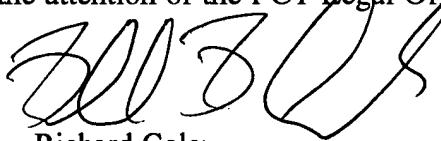
The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Office of PCT Legal Administration, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office


Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459


Richard Cole
PCT Legal Examiner
PCT Legal Office